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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,351	05/15/2001	Juergen Hoefig	P01,0136	1790
21171	7590	05/24/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			SING, SIMON P	
			ART UNIT	PAPER NUMBER
			2645	
DATE MAILED: 05/24/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/858,351	HOEFIG, JUERGEN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Simon Sing	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 03/112/2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date 8. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Objections***

1. Claim 14 is objected to because of the following informalities: "the control communication facility" in line 4 should be changed to "the central communication facility" as in line 2. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2 Claims 17 and 18 recite the limitation "the connection" in line 1. There is insufficient antecedent basis for this limitation in the claim (claim 14 recites a first connection, a second connection, and a third connection).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Martinez US 5,784,438.

3.1 Regarding claim 1, Martinez discloses an automatic callback method. Martinez teaches:

entering a telephone number on a local communication facility (telephone 2 and LECI Switch 6) (figure 1; column 3, lines 34-37);

initializing a setup of a connection between said local communication facility and a central communication facility (centralized call detail recoding platform 14, LEC 8 and telephone 8) (figure 1; column 3, lines 37-45);

activating, by a central control unit (within platform 14) of said central communication facility, a callback module (within platform 14) of said central communication facility (column 3, lines 46-65);

terminating said setup of said connection without making said connection between telephone 2 and telephone 4 (column 4, lines 27-30); and

automatically initializing a setup, by said central control unit, of a new connection between said central communication facility and said local communication facility by accessing said callback module (column 4, lines 38-62).

3.2 Regarding claim 2, Martinez teaches identifying a subscriber by a called number before activating said callback module (column 3, lines 41-44).

3.3 Regarding claim 4, Martinez teaches that a caller enters a callback code \*67 before hung-up (column 3, lines 46-58).

3.4 Regarding claim 5, Martinez teaches automatically transmitting the telephone number to the central communication facility (column 3, lines 37-40).

3.5 Regarding claim 6, Martinez teaches setting up a new connection using a calling party's number (column 4, lines 38-41) and the callback code \*67 (column 3, lines 46-51).

4. Claims 1, 2, 3, 8, 9 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamasaki US 6,307,928.

4.1 Regarding claim 1, Yamasaki discloses a method for automatic callback (figure 1; column 5, lines 21-43; column 6, lines 28-34; column 9, lines 43-67). Yamasaki teaches:

entering a telephone number on a local communication facility (terminal 13 and ATM Exchange 11) (figure 2; column 13, lines 10-17, 40-43);

initializing a setup of a connection between said local communication facility and a central communication facility (ATM Exchange 12 and terminal 14) (figure 2; column 13, lines 44-47);

activating, by a central control unit 24 of said central communication facility, a callback module 25 of said central communication facility (figure 3, column 13, lines 47-51; column 17, lines 33-51);

terminating said setup of said connection without making said connection (column 17, lines 29-33); and automatically initializing a setup, by said central control unit, of a new connection between said central communication facility and said local communication facility by accessing said callback module (column 17, lines 29-33).

4.2 Regarding claim 2, Yamasaki teaches a subscriber data 21a for identifying the subscriber (figure 3; column 13, line 20 column 18, lines 8-15, 36-43).

4.3 Regarding claim 3, Yamasaki teaches a subscriber data 21a for identifying the subscriber terminal number (column 18, lines 8-15, 36-43). It is inherent that a subscriber data includes a subscribers' name (codeword).

4.4 Regarding claim 8, Yamasaki teaches setting a timer for a delay before setting up said new connection (column 20, lines 36-53).

4.5 Regarding claim 9, Yamasaki discloses an ATM Exchange 12 in figure 2, comprising:

access units 18 for connecting communication terminals 14 and ATM communication network (column 12, lines 35-41);

a central control unit 20 for controlling functions of said ATM Exchange, comprising a callback module 25 and a database 21 (figure 3; column 13, lines 40-43; column 18, lines 8-15, 36-41);

said central control unit 20 being designed such that it terminates a setup of a connection without making the connection (column 17, lines 29-33), the setup being initialized by an entry of a specific telephone number on a terminal 13 (remote communication terminal) (column 13, lines 44-47), the connection being between said remote communication terminal and said ATM Exchange 12 by accessing said callback module and said database (column 4, lines 21-30); and the central control unit 20 automatically initializing a setup of a new connection (column 17, lines 29-39).

4.6 Regarding claim 14, Yamasaki discloses a method for automatic callback (figure 1; column 5, lines 21-43; column 6, lines 28-34; column 9, lines 43-67). Yamasaki teaches:

entering a specific telephone number on a local communication facility (figure 2, terminal 13 and ATM Exchange 11; column 13, lines 10-17, 44-47; column 14, lines 46-47);

communicating the telephone number to a central communication facility (ATM Exchange 12) via a first connection (column 13, lines 47-55);

initializing, after entering the specific telephone number, a setup of a second connection between said local communication facility and said central communication facility (column 13, lines 20-21);

activating, by a central control unit 20 of said central communication, a callback module 25 of said central communication facility (figure 3; column 17, lines 33-39);

terminating said setup of said second connection without making said second connection (column 17, lines 29-33); and

automatically initializing a setup, by said central control unit, of a third connection between said central communication facility and said local communication facility by accessing said callback module (column 17, lines 33-39).

5. Claims 1, 2, 4, 5, 7, 9-11 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Livanos US 5,311,574.

5.1 Regarding claim 1, Livanos discloses an automatic callback method for an automatic call distribution system. Livanos teaches:

entering a telephone number on a local communication facility (telephone 117 and Local Switching System 110) (figure 1; column 4, lines 18-20);

initializing a setup of a connection between said local communication facility and a central communication facility (Automatic call Distribution (ACD) 140) (column 4, lines 20-21);

activating, by a central control unit 142 of said central communication facility if queue (delay) time is above a predetermined threshold, a callback module of said central communication facility (column 4, lines 21-30);

terminating said setup of said connection without making said connection (column 4, lines 27-30); and automatically initializing a setup, by said central control unit 142, of a new connection between said central communication facility and said local communication facility by accessing said callback module (column 4, lines 30-34).

5.2 Regarding claim 2, Livanos teaches identifies a subscriber (calling party' caller ID) before activating said callback module (column 4, lines 22-24).

5.3 Regarding claim 4, Livanos teaches prompting a calling party with a text message whether the calling party wants to be called back (column 4, lines 24-27). It is inherent that the calling party must enter an affirmative answer, such as YES, to activate the callback.

5.4 Regarding claim 5, Livanos teaches transmitting caller ID (CLI) to the central communication facility (column 4, lines 22-24).

5.5 Regarding claim 7, Livanos teaches using a caller ID stored in a queue to setup said new connection (column 4, lines 30-34).

5.6 Regarding claim 9, Livanos discloses an Automatic Call Distribution (ACS) system 140 in figure 1, comprising:

access units (ACD switches or line interfaces) for connecting communication terminals (telephone 115-117, 135-137) and communication network 120 to said ACD system 140 (figure 1);

a central control unit 142 for controlling functions of said ACD system, comprising a callback module (not shown) and a database (queue 190) (column 4, lines 30-34);

said central control unit 142 being designed such that it terminates a setup of a connection without making the connection, the setup being initialized by an entry of a specific telephone number on a telephone 117 (remote communication terminal), the connection being between said remote communication terminal and said ACD system 140 by accessing said callback module and said database (column 4, lines 21-30); and the central control unit 142 automatically initializing a setup of a new connection by said ACD system (column 4, lines 30-34).

5.7 Regarding claims 10 and 11, Livanos teaches that the telephone 117 is an ISDN phone (column 3, lines 26-28) and the connection is through an ISDN useful data channel (column 8, lines 37-49).

5.8 Regarding claim 14, Livanos discloses an automatic callback method for an automatic call distribution system. Livanos teaches:

entering a specific telephone number on a local communication facility (telephone 117 and Local Switching System 110) (figure 1; column 4, lines 18-20);

communicating the telephone number to a central communication facility

(Automatic call Distribution (ACD) 140) via a first connection (column 4, lines 22-24; column 8, lines 37-49);

initializing, after entering the specific telephone number, a setup of a second connection between said local communication facility and said central communication facility (column 4, lines 20-21);

activating, by a central control unit of said central communication facility if queue (delay) time is above a predetermined threshold, a callback module of said central communication facility (column 4, lines 21-30);

terminating said setup of said second connection without making said second connection (column 4, lines 27-30); and

automatically initializing a setup, by said central control unit, of a third connection between said central communication facility and said local communication facility by accessing said callback module (column 4, lines 30-34).

5.9 Regarding claim 15, Livanos discloses that the telephone 117 is an ISDN phone and teaches:

the first set connection is over a signaling channel (column 3, lines 26-28; column 8, lines 37-49); and

the second connection is over a useful data channel (voice data channel such that a caller at may communicate with an agent at telephone 150) (column 4, lines 20-21).

5.10 Regarding claims 16 and 17, Livanos teaches that the setup of the second channel is initialized by the local communication facility (telephone 117 initiates a call) (column 4, lines 18-20).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12, 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livanos US 5,311,574 in view of Mills US 5,815,505.

Livanos teaches an ISDN network, but fails to teach that ISDN uses time division multiplex.

However, Mills discloses a communications device in figure 2. Mills teaches that ISDN uses time division multiplex (column 6, lines 30-46).

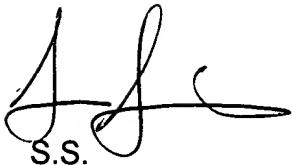
Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Livanos' reference with Mills teaching so that ISDN comprises time division multiplex, because such a modification would have enable Livanos' system to transmit multiple separated data over one medium channel.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,377,576 (ZWICK et al.) discloses a method for automatic callback (reverse calling) (column1, lines 35-49).

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



05/17/2004

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